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10/593,266	09/18/2006	Satoru Banzai	1009682-000163	6449
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EXAMINER KENNEDY, NICOLETTA				
ART UNIT		PAPER NUMBER		
1611				
NOTIFICATION DATE		DELIVERY MODE		
12/06/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
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Office Action Summary

Application No.

10/593,266

Applicant(s)

BANZAI, SATORU

Examiner

Nicoletta Kennedy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 9, 13-15, 19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-9, 13-15, 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-7, 10-12, 16-18 and 20 are cancelled. Claim 19 is withdrawn. Claims 8-9, 13-15 and 21 are currently pending.

Priority

This application, filed September 18, 2006, is a national stage entry of PCT/JP05/02784, filed February 22, 2005, and claims foreign priority to Japanese application 2004-074665, filed March 16, 2004. The International Bureau has provided a certified copy of the Japanese application.

Maintained Rejections

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The rejection of claims 8-9, 13-15 and 21 under 35 U.S.C. 102(b) as being anticipated by Nishihama et al. (US 6,358,495) (issued Mar. 19, 2002) as evidenced by Encarta® World English Dictionary [North American Edition] © & (P) 2009 (previously supplied) is maintained.

Regarding claims 8-9, 13-15 and 21, Nishihama et al. teach a titanium-silica complex and cosmetic preparation compounding the same (title). The titanium-silica

complex is a fine particle mesoporous powder (column 4, lines 28-37). The lipstick formulation of example 4 is also comprised of mica (an extender material) and titanium oxide (a pigment) (column 12, example 4). The formulation may take the form of a cosmetic pencil (column 10, line 13).

Although Nishihama et al. do not describe the pore size of the mesoporous powder, this is an inherent property of the powder. A mesopore is defined as a pore with a diameter of 2-50 nanometers (Encarta definition).

Additionally, although Nishihama et al. do not specifically state that the mesoporous powder binds the extender and pigment, the invention as claimed is not structurally distinguishable from that of Nishihama et al. and it is therefore the examiner's position that the ability of the mesoporous powder to bind the extender and pigment is an inherent property of the invention taught by Nishihama et al. Since the Patent and Trademark Office does not have the facilities for examining and comparing the claimed cosmetic stick with the cosmetic stick of Nishihama et al., the burden of proof is upon the Applicants to show an unobvious distinction between the structural and functional characteristics of the claimed cosmetic stick and the cosmetic stick of the prior art. See In re Best, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 197) and Ex parte Gray, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

Response to Arguments

Applicant's arguments filed September 17, 2010 have been fully considered but they are not persuasive. First, with regard to the photographs filed with the response,

the photographs must be submitted in declaration or affidavit form. See MPEP 716.01(a) and 716.02(g). As such, the photographs cannot be considered at this time.

Because these photographs constitute Applicant's arguments, the rejection of record is maintained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. The rejection of claims 8-9, 13-15 and 21 under 35 U.S.C. 103(a) as being unpatentable over Appel et al. (US 6,579,530) (issued June 17, 2003) is maintained.

Regarding claims 8-9, 13-15 and 21, Appel et al. teach a cosmetic powder pencil comprising colorants, mica (extender material) and silica (ceramic) (claims 1, 7 and 9). The colorant may be iron oxide black (a pigment) (column 3, example 2). However,

Appel et al. do not teach the pore size of the silica. The MPEP as evidenced by Nakanishi cure this deficiency.

MPEP 2144.05 states that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" quoting *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In the instant case, a cosmetic pencil comprising silica, mica and a pigment is known in the art. Manipulating the pore size of the silica is to find the optimum or workable range is not inventive.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art to have combined the teachings of Appel et al. to formulate a cosmetic powder pencil comprising pigment, mica and silica and to have manipulated the pore size of the silica. One would have been motivated to do so because Appel et al. teach that the diameter of the pencil may be manipulated, thus suggesting manipulation of the particle sizes and pore sizes of the components of the pencil (column 3, lines 33-36).

Additionally, although Appel et al. do not specifically state that the silica binds the extender and pigment, the invention as claimed is not structurally distinguishable from that of Appel et al. and it is therefore the examiner's position that the ability of the silica to bind the extender and pigment is an inherent property of the invention taught by Appel et al. Since the Patent and Trademark Office does not have the facilities for examining and comparing the claimed cosmetic stick with the cosmetic stick of Appel et al., the burden of proof is upon the Applicants to show an unobvious distinction between the structural and functional characteristics of the claimed cosmetic stick and the

cosmetic stick of the prior art. See In re Best, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 197) and Ex parte Gray, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

Response to Arguments

Applicant's arguments filed September 17, 2010 have been fully considered but they are not persuasive. First, with regard to the photographs filed with the response, the photographs must be submitted in declaration or affidavit form. See MPEP 716.01(a) and 716.02(g). As such, the photographs cannot be considered at this time.

Because these photographs constitute Applicant's arguments, the rejection of record is maintained.

Citation of Relevant Art not Relied Upon by Examiner

6. Several of the references disclosed on the IDSs filed by applicant read upon the instant claims. Instead of making cumulative rejections, the examiner points out these references as relevant to the claimed invention: JP 02-172902, JP 59-093014, JP 61-176513 and WO 03/106334

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicoletta Kennedy whose telephone number is (571)270-1343. The examiner can normally be reached on Monday through Friday 11:30 to 8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Gollamudi Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/N. K./

Examiner, Art Unit 1611

/Anne R Kubelik/

Primary Examiner, Art Unit 1638